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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,685	01/23/2002	Yoshifumi Tanimoto		8901

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EXAMINER

WILLIAMS, JEFFERY L

ART UNIT PAPER NUMBER

2137

DATE MAILED: 08/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/057,685	TANIMOTO, YOSHIFUMI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jeffery Williams	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/23/02</u> . | 6) <input type="checkbox"/> Other: _____  |

RP

## DETAILED ACTION

### *Drawings*

Figure 5 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 9, 12, 13, 15, 16, and 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Regarding these claims, they are directed to an apparatus comprising means shown to be solely software ("a program"). Thus, these claims are rejected as not being tangible.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the applicant's admitted Prior Art in view of Herfert, "Security-Enhanced Mailing Lists".

Regarding claim 16, the applicant's admitted Prior Art discloses an apparatus (Instant Application, fig. 5, par. 5) having *means for creating a first common key from a public key generated based on an email address of a receiver and a first secret key generated based on a predetermined email address* (Instant Application, pars. 6 – 8); *means for sending an email including data encrypted with the first common key, to the receiver* (Instant Application, par. 8); *and means for creating a second common key from a public key generated based on an email address of a sender of a received email and a second secret key generated based on the email address of the receiver* (Instant Application, par. 8); *and means for decrypting encrypted data included in a received email by utilizing the second common key* (Instant Application, par. 8).

The applicant discloses, as admitted Prior Art, a secure messaging system known as ID-NIKS. In ID-NIKS, a sender of an email encrypts a message with a common key and sends the message to a receiver. The receiver, in turn, is enabled to

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decrypt the message by utilizing a common key. The applicant's admitted Prior Art does not disclose that the receiver of the encrypted message may be a mailing list.

Herfert discloses that it is known in the art to send an encrypted email message to a mailing list (Herfert, page 1, par. 1). According to the Microsoft Press Computer Dictionary, 3<sup>rd</sup> ed., a "mailing list" is defined as a receiver of a message that enables the distribution of the message (or an edited version of the message) to a plurality of individuals. Thus, Herfert discloses that it was known in the art for a receiver of an encrypted message to be a mailing list.

It would have been obvious to one of ordinary skill in the art to combine the teaching that a receiver of an encrypted email may be a mailing list with the ID-NIKS system for sending an encrypted email to a receiver as disclosed as admitted Prior Art by the applicant. This would have been obvious because one of ordinary skill in the art would have been motivated to advantageously allow a sender to send a *single* encrypted email to a receiver such that the message may be distributed to a *plurality* of individuals, thereby allowing a user to derive the benefits of a mailing list.

Regarding claim 17, the combination of the applicant's admitted Prior Art and Herfert discloses:

*a recording medium for storing the first secret key and the second secret key* (Instant Application, fig. 5). As shown, the sending and receiving entities have mediums for storing the first and second secret keys.

Regarding claim 18, it is obvious that the combination of the applicant's admitted Prior Art and Herfert includes *wherein the email the apparatus sends is broadcast to the at least one recipient from a machine which handles the mailing list*. This is obvious because the definition of mailing list according to the Microsoft Press Computer Dictionary, 3<sup>rd</sup> ed. details that the machine which handles the mailing list "automatically sends the message to all the addresses on the list (possibly allowing a moderator to edit it first) ".

Regarding claim 19, the combination of the applicant's admitted Prior Art and Herfert discloses:

*wherein the predetermined email address is an email address of the apparatus* (Instant Application, par. 8).

Regarding claims 1, 2, 4, and 5, they are the method claims employed by the apparatus claims 16 and 18, and they are rejected for the same reasons.

Regarding claims 3 and 6, the combination of the applicant's admitted Prior Art and Herfert discloses:

*the secret key is generated by a center and the secret key is prepared by a center* and distributed to the senders and the receivers (Instant Application, fig. 5). The combination of applicant's admitted Prior Art and Herfert does not disclose that the secret key is distributed to the senders and receivers via email.

Herfert, however discloses that an email system employing a center can send a necessary encryption/decryption key to users of the email system via email. It would have been obvious to one of ordinary skill in the art to employ the method of Herfert, for sending an encryption/decryption key by a center via email, with the system of the combination of the applicant's admitted Prior Art and Herfert. This would have been obvious because one of ordinary skill in the art would have been motivated to conveniently provide senders and receivers within an established email system with the necessary keys via the utilization of the already established infrastructure, namely the email system.

Regarding claims 7 and 8, they are the computer readable medium and program claims employed by the apparatus claims 16 and 17, and they are rejected for the same reasons.

Regarding claims 9 – 15, they are apparatus claims substantially similar to the apparatus claims 16 – 19, and they are rejected for the same reasons.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

J. Linn, "RFC 1421 – Privacy Enhancement for Internet Electronic Mail: Part I: Message Encryption and Authentication Procedures", Feb. 1993., Internet RFC Archives.

Sakakibara et al., "The ID-based Non-interactive Group Communication Key Sharing Scheme using Smart Cards", 1994, IEEE.

Matsui et al., "Security Method, Security Software and security System for Electronic Communications", U.S. Patent 6,742,111 B1.

Harvey et al., "Group Key Management Protocol (GKMP) Architecture", July 1997, RFC 2094.

A shortened statutory period for reply is set to expire **3 months** (not less than 90 days) from the mailing date of this communication.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery Williams whose telephone number is (571) 272-7965. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone

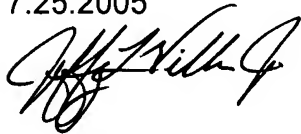


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number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeffery Williams  
Assistant Examiner  
Art Unit 2137  
7.25.2005



EMMANUEL L. MOISE  
SUPERVISORY PATENT EXAMINER